June 29, 2020

Via Electronic Transmission

The Honorable Chuck Grassley
Chairman
Senate Finance Committee
United States Senate
517 Hart Senate Office Building
Washington DC 20510

The Honorable Ron Wyden
Ranking Member
Senate Finance Committee
United States Senate
393 Russell Senate Office Building
Washington DC 20510

Dear Chairman Grassley and Ranking Member Wyden:

I write today on behalf of the Section of Intellectual Property Law of the American Bar Association (“ABA-IPL Section” or the “Section”) regarding the ABA-IPL Section’s views on enhancing the authority of United States Customs and Border Protection (“CBP”) to enforce United States design patents. The views expressed herein are presented on behalf of the Section and have not been approved by the House of Delegates or the Board of Governors of the American Bar Association (the “ABA”). Accordingly, they should not be construed as representing the position of the ABA.

Since 1894, the ABA-IPL Section has advanced the development and improvement of intellectual property laws and their fair and just administration. As the forum for diverse perspectives and balanced insight on the full spectrum of intellectual property law, the Section serves within the ABA as a highly respected voice within the intellectual property profession, before policy makers, and with the public.

The ABA-IPL Section has long supported CBP’s mission to prevent the importation of goods into the United States that infringe United States intellectual property rights. In particular, the Section has supported legislation that protects against importation of counterfeit goods, imposes civil remedies for online piracy and counterfeiting, and improves intellectual property enforcement worldwide against trademark counterfeiting and copyright piracy.
The ABA-IPL Section supports amending Section 596(c)(2)(C) of the Tariff Act of 1930 (19 U.S.C. § 1595a(c)(2)(C)) and adopting regulations necessary to provide statutory and regulatory authority to CBP to create the same border enforcement protection for United States design patents as is currently extended to copyrights, trademarks and trade dress rights. Accordingly, the ABA-IPL Section supports enactment of S.2987, 116th Congr., 1st Sess. (2019), the Counterfeit Goods Seizure Act of 2019 (“CGSA”), to authorize CBP to seize imported merchandise that infringes a design patent.

Such authorization would greatly enhance CBP’s capability to address the priority trade issue of stopping counterfeit goods at the border. As noted in DOJ enforcement actions, counterfeiters often ship fake and illicit goods separately from counterfeit labels in an effort to avoid detection and seizure by CBP officials based on registered trademarks.¹ Once in the country, the counterfeit labels are applied to the fake and illicit goods and sold to unwitting consumers. CBP authority to seize fake and illicit goods based on design patent infringement would help curtail such evasion of CBP enforcement.

Moreover, as the only jurisdiction of the ID5 forum not to enforce patented or registered designs at the border, the United States should join its peers in Europe, Japan, Korea and China in enforcing patented or registered designs at the border. Such enforcement would advance the ID5 forum’s goal of furthering the development of user-friendly industrial design projections systems on a global scale.

Thank you in advance for your consideration of this letter. If you have any questions, please do not hesitate to contact me.

Sincerely,

George W. Jordan III
Chair, ABA Section of Intellectual Property Law